REMARKS

The application is a US National Phase Application under 35 USC§371. The examiner has imposed a Restriction Requirement, where the claims are divided into four groups:

- Group I claims compounds having specified selections for R^3, X, Y, Z, R^7 and R^8.
- Group II claims all other compounds.
- Group III claims a method of using the compounds of Group I.
- Group IV claims a method of using the compounds of Group II.

The Applicants respectfully elect group I, with traverse.

The Examiner alleges that the claims lack unity of invention because they do not have a special technical feature that defines a contribution over the prior art. US Patent 6,372,742 (Chin, et al) is cited as evidence that the claims do not have such a common special technical feature. The Examiner is misapplying the explanation of the common technical feature as applied to Markush practice in MPEP§1850.III.B.

The compounds described in this application and in Chin et al. are all based on indoles. However, the indoles in this application and in Chin et al. are different. The common structural feature can be more specifically defined than merely being indoles. Furthermore, the compounds in Chin et al. are useful in the treatment of cancer, whereas the compounds in the pending claims have a different utility, which is the treatment of type 2 diabetes.

The applicants' compounds have a common structural feature (indoles having a carboxylic acid or tetrazole as part of the substitution on the 3-position of the indole), and a common activity (treatment of diabetes). This common structural feature differs from the compounds of Chin et al., which have a thiazolidinedione group on the 3-position of the indole. The compounds of Chin et al. also have a different activity (treatment of cancer rather than diabetes). Thus the common technical features of Applicants' claims are novel over those of Chin et al.

It is therefore clear that the applicants' claims meet the requirements of unity of invention as defined in MPEP§1850.III.B at the bottom of page 1800-97, 2nd column, for Markush practice, where the common criteria are: (A) All alternatives have a common activity, and (B)(1) All alternatives have a common significant structural element, as described above.

The common criteria must also be novel. Neither of the common criteria for applicants' claims overlaps the criteria of Chin et al. The common structural features of Applicants' compounds are novel over the structural features of Chin et al, and the utilities are different. It is therefore respectfully submitted that Chin et al has no relevance to whether applicants' claims have unity of invention.

Finally, the examiner states that Groups III and IV each lack unity of invention over Groups I and II respectively. Since Groups III and IV are directed to the use of the compounds of Groups I and II, these are different categories of claims that are permitted to be claimed together as one invention, as explained in MPEP§1850.III.A, subparagraph (A), at the bottom of page 1800-96, column 2, which states that a product and the use of the product are the same invention for purposes of unity of invention.

Therefore, the Restriction Requirement is improper, and it should be withdrawn.

As this response is timely, no fee is due. If any other fee is due, it may be charged to Merck Deposit No. 13-2755.

If the Examiner wishes to discuss any matter associated with this response, the Examiner is invited to telephone the undersigned attorney.

Respectfully submitted,

By _____

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